

Application No. 09/680,118  
Amendment "E" dated December 3, 2004  
Reply to Office Action mailed September 21, 2004

### REMARKS

The Office Action mailed September 21, 2004, considered claims 1-25. Claims 1-25 were rejected under 35 U.S.C. § 102(b) as being anticipated by Bernstein (U.S. Patent No. 5,297,249)<sup>1</sup>.

By this paper, claims 1, 17, 19 and 25 have been amended and new claims 27-29 have been added, such that claims 1-25 and 27-29 remain pending for consideration, of which claims 1, 17, 19, 25 are the independent claims at issue.

As reflected in the claim listing above, the invention is generally directed to a method for altering a high-level document command comprising one or more operations to be performed on a document, such as email or email folders. The recited method includes receiving a high-level document command meeting certain criteria and prior to implementing the high-level document command, identifying one or more client applications that are to be notified of the receipt of the high-level document command meeting certain criteria. Also, prior to implementing the single high-level document command, the method includes notifying the one or more identified client applications that the high-level document command meeting the certain criteria has been received as a result of receiving the single high-level document command. Modifying instructions are also received from the one or more client applications on how to affect the implementation of the single high-level document command. Thereafter, the one or more operations included in the single high-level document command are altered according to the modifying instructions.

As described throughout the specification, notifying client applications of the receipt of a high-level document command, prior to implementation, is useful "so that the client application may return back implementation instructions on how to implement the high-level document command. ...For example, the instruction may be for preventing the implementation of the high-level document command altogether. The instruction may also be to change how the high-level document command is implemented. The instruction may even be for implementing one or more high-level document commands in addition to the received high-level document command.

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<sup>1</sup> Although the prior art status of the cited art is not being challenged at this time, Applicants reserve the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

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Thus, the notified third party client application is given extensive control over how the high-level document command is implemented..." Page 5, line 16 thru Page 6, line 2.

This is to be contrasted with the prior art systems disclosed in Beizer and Bredenberg, which were clearly distinguished away from in the last amendment. Although the Examiner failed to respond to the distinctions made in the last amendment, the Examiner appears to agree with Applicants' remarks regarding the distinctions between the present invention and the cited art (Beizer and Bredenberg) inasmuch as the rejections to the independent claims are now no longer based on either Beizer or Bredenberg. Instead, the Examiner is rejecting the independent claims solely based upon a newly cited reference (Bernstein).

It will be pointed out with specific regard to these previously cited references, however, that at least some of the present rejections to the claims are invalid insofar as they are stated as being based solely on 35 U.S.C. 102 under Bernstein, while at the same time they are based at least in part on the previously cited art (see the rejections to dependent claims 11 and 12, for example).

Now, with specific regard to the independent claims and the newly cited art, Bernstein, Applicants respectfully submit that Bernstein fails to anticipate or obviate the claimed invention. In particular, while the present invention is directed to modifying high-level document commands comprising one or more operations to be performed on a document, Bernstein fails to even address high-level document commands that comprising any types of operations to be performed on a document. Instead, Bernstein is directed to hypermedia link marker abstract and search services that essentially comprises a "presentation system which utilizes several client applications, such as a word processor, a slide show, an audio show and the like, to provide an end user with multiple choices to access information on a particular topic." Col. 9, ln 64 – Col. 10, ln. 3.

Although Bernstein clearly states that the "LMS uses [a notification] mechanism to allow client applications to optionally be aware of, qualify, limit, modify, or prevent actions that LMS is about to take," (Col. 15, ll. 18-20) the actions the LMS takes are not high-level document commands comprising one or more operations to be performed on a document, particularly email documents, as claimed in the present invention. Instead, the LMS system in Bernstein merely provides a uniform and consistent End User Interface by performing functions that were previously performed by client applications for generating menus and dialog boxes to thereby

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assure an absolutely uniform and consistent interface through which many client applications can be launched. Col. 9, ll. 29-45. As further described, it is through this interface that data can be accessed from the various client applications. Col. 9, ll. 43-50.

In no event does Bernstein discuss or suggest that the LMS system performs high-level document commands to the data or documents that are accessed from the various client applications, as claimed in the present invention.

To further clarify this distinction between the present invention and the cited art, the claims have been amended to clarify that the present invention is directed to implementing high-level document commands comprising one or more operations to be performed on a document. It will be appreciated, however, that this limitation was already present in the preamble of the some of the claims. Accordingly, it is now merely being restated within the body of the claims.

The claims have also been amended to further clarify that the document is one of an e-mail document and an email folder. This new claim element further distinguishes the invention over the art of record when considered in combination with the other recited claim elements. In particular, Bernstein fails to address or disclose any embodiment in which high-level documents commands are used to perform actions on email documents or email folders.

In the last office action, the Examiner suggested that Bernstein did disclose email embodiments when rejecting some dependent claims. However, the passages cited by the Examiner for support of his rejection actually had nothing whatsoever to do with email. For example, with specific regard to claim 8, dealing with email folders, the Examiner cited to Col. 9, line 44-Col. 10, line 15 of Bernstein. This passage, however, only addressed the presentation type system provided by Bernstein, not email or email folders.

In fact, with regard to the Examiner's support for many of his rejections, Applicants are somewhat confused as to why the Examiner cited the passages he did because the cited passages do not appear to support or clarify the Examiner's rejections. See, for example, the rejections to claim 2 (regarding grouping commands), claims 3-4 (regarding atomic execution), claims 7 and 8 (regarding email), claims 9-10 and 13 (regarding moving, deleting and adding a document), claim 14 (regarding the system configuration), etc.

Accordingly, for at least the foregoing reasons, Applicant respectfully submits that the cited art fails, either singly or in combination, to teach or suggest the methods recited in the pending claims. This is particularly true, when considering that the claims recite how the high-

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level document commands comprise one or more operations to be performed on one of an email message and an email folder. The newly added dependent claims are also distinguished from the art of record inasmuch as they depend from claim 1. The new dependent claims focus on specific embodiments in which the high-level document command comprises a command to prevent the email from being stored when the email contains certain offensive words (claim 27), to change text in the email (claim 28), and to copy the email to at least one in-box other than an in-box of an intended recipient of the email upon determining that the email is marked as urgent (claim 29). Support for the new claims is found on page 15 and 16 in the specification.

For at least the forgoing reasons, Applicant respectfully submits that all of the pending claims, 1-25 and 27-29 are now in condition for prompt allowance. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 3 day of December 2004.

Respectfully submitted,



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